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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/003,446	10/26/2001	Shigeo Yoshida	11283-015001 / PH-1269US	7360
26211	7590	10/07/2005	EXAMINER	
FISH & RICHARDSON P.C. P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			MARSCHER, ARDIN H	
			ART UNIT	PAPER NUMBER
			1631	

DATE MAILED: 10/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

10/003,446

Applicant(s)

YOSHIDA ET AL.

Examiner

Ardin Marschel

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**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 27 May 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☒ The Notice of Appeal was filed on 30 June 2005. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See *Continuation Sheet*. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 1-8.  
Claim(s) withdrawn from consideration: 9-25.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
for reasons of record as further explained as attached.  
12. ☒ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). (1 sheet)  
13. ☐ Other: \_\_\_\_\_.

Continuation of 3. NOTE: "control virtual" 2-D pattern is a new issue requiring further consideration and/or search.

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### DETAILED ACTION

Further explanation of item # 11 on the enclosed Advisory action:

Both of the rejection based on 35 USC 103(a) are maintained and reiterated from the previous office action, mailed 12/28/04, due to non-entry of the proposed amendment, filed 5/27/05, due to leaving the claims rejected as previously set forth.

Applicants argue that Vijg et al. makes a 2-D electrophoresis pattern without using DNA sequence information but rather only involves physically manipulating the DNA. In response the instant claims do not limit what is performed in producing a control 2-D electrophoresis pattern thus manipulating DNA followed by production comprising nucleic or genomic nucleotide sequence information as in Vijg et al. is included in the broadly worded instant claims thus supporting this rejection. Applicants go on to further argue that relating spots to restriction fragments is analyzing an already created 2-D electrophoretic pattern. In response as described above this is all part of the total pattern production and not separated out in the instant claims as argued and therefore non-persuasive in distinguishing the instant claims over the reference. Applicants then argue that In re Venner regarding automation vs. manual methodology specifically regarding the analyzing of 2-D patterns. In response, the usage of In re Venner in this rejection is to support any virtual or computer program execution of the method of Vijg et al. which as noted above continues to support this rejection. The In re Venner decision is not utilized to support the producing steps of a control 2-D electrophoretic pattern as described sufficiently in Vijg et al. It is added that even if the amendment, filed 5/27/05, would have been entered the virtual control patterning of Vijg et al. via restriction fragment analysis or automation of any part as in In re Venner would still support this rejection.

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Applicants then argue regarding the rejection of claims 1-8 based on Vijg et al. taken in view of In re Venner, and further in view of Stevens et al. Applicants again point to arguments already responded to above as non-persuasive and they are non-persuasive for the same reasons here. Applicants then go on to argue that Stevens et al. merely disclose a networked set of sequencing machines linked to a central computer. This argument is apparently arguing this reference independent of the combination of references on which this rejection is based. Since the rejection is based on the combination of references and not on any single reference this argument is moot. Applicants go on to argue that there is no motivation to combine the references. In response motivation to combine was set forth in the previous office actions and not argued specifically. This allegation of no motivation therefore is not directed to the basis for the rejection and therefore also moot.

No claim is allowed.

Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the Central PTO Fax Center. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993)(See 37 CFR § 1.6(d)). The Central PTO Fax Center number is (571) 273-8300.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ardin Marschel, Ph.D., Supervisory Patent Examiner, whose telephone number is (571) 272-0718. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

Any inquiry of a general nature or relating to the status of this application should be directed to Legal Instrument Examiner, Tina Plunkett, whose telephone number is (571) 272-0549.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

October 1, 2005

*Ardin H. Marschel 10/2/05*  
**ARDIN H. MARSCHEL**  
**SUPERVISORY PATENT EXAMINER**